



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,631	04/06/2001	Joseph James Valorose III	D5009-00018	5521

8933 7590 07/21/2005

DUANE MORRIS, LLP
IP DEPARTMENT
ONE LIBERTY PLACE
PHILADELPHIA, PA 19103-7396

EXAMINER

RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,631

Applicant(s)

VALOROSE, JOSEPH JAMES

Examiner

Laurie Ries

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-17 and 19-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3,5-17 and 19-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 06 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: amendment, filed 4 May 2005, to the original application filed 6 April 2001.
2. The rejection of claim 18 under e35 U.S.C. 101 has been removed as necessitated by amendment.
3. The rejection of claims 3 and 4 under 35 U.S.C. 112, second paragraph, has been removed as necessitated by amendment.
4. The rejection of claims 1-3, 5, and 8-18 under 35 U.S.C. 103(a) as being unpatentable over Jamtgaard (U.S. Patent 6,430,624 B1) in view of Huang (U.S. Provisional Application 60/179,330) has been removed as necessitated by amendment and newly found prior art.
5. The rejection of claim 4 under 35 U.S.C. 103(a) as being unpatentable over Jamtgaard (U.S. Patent 6,430,624 B1) in view of Huang (U.S. Provisional Application 60/179,330) and Ballantyne (U.S. Patent 6,687,873 B1) has been removed as necessitated by amendment.
6. The rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over Jamtgaard (U.S. Patent 6,430,624 B1) in view of Huang (U.S. Provisional Application 60/179,330) and

Art Unit: 2176

Barile (U.S. Patent 6,560,621 B2) has been removed as necessitated by amendment and newly found prior art.

7. The rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over Jamtgaard (U.S. Patent 6,430,624 B1) in view of Huang (U.S. Provisional Application 60/179,330) and DeRose (U.S. Patent 5,557,722) has been removed as necessitated by amendment and newly found prior art.

8. The rejection of claims 19-20 under 35 U.S.C. 103(a) as being unpatentable over Jamtgaard (U.S. Patent 6,430,624 B1) in view of Ballantyne (U.S. Patent 6,687,873 B1) has been removed as necessitated by amendment and newly found prior art.

9. Claims 1-3, 5-17, and 19-22 are pending. Claims 4 and 18 have been cancelled. Claims 21-22 are newly added claims. Claims 1, 15, 16, 17, and 19 are independent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-3, 5, and 8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jamtgaard (U.S. Patent 6,430,624 B1) in view of Huang (U.S. Provisional Application 60/179,330) and Carter (U.S. Patent 6,201,611 B1).

As per claim 1, Jamtgaard discloses a computer-implemented method for generating electronic documents including providing a computer program for receiving data from at least one application program (See Jamtgaard, Column 8, lines 25-46, and Figure 5, element 60), dividing the data into text data, graphics data, and context data (See Jamtgaard, Column 13, lines 24-67, and Column 14, lines 1-3), storing in cards at least a portion of the text data, graphics data, or context data, where at least a portion of the context data is stored in XML format (See Jamtgaard, Column 13, lines 45-50). Jamtgaard does not disclose expressly generating at least one file for storing at least a portion of the data. Huang discloses generating a file to store data (See Huang, Page 13, lines 21-23). Jamtgaard also does not disclose expressly registering with an operating system of a computer as a printer driver and receiving the data in the form of a print stream. Carter discloses registering a print device with a server (See Carter, Column 5, lines 43-54) and receiving data in the form of a print stream (See Carter, Column 5, lines 66-67, and Column 6, lines 1-2). Jamtgaard, Huang and Carter are analogous art because they are from the same field of endeavor of manipulating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the file of Huang with the storage of at least a portion of data of Jamtgaard. The motivation for doing so would have been to enable the export of data into a document database (See Huang, Page 13, lines 21-24). At the time of the invention it would also have been obvious to include the registering of the print driver of Carter with the method of Jamtgaard. The motivation for doing so would have been to

allow thin clients to find an appropriate server to perform print rendering services (See Carter, Column 5, lines 48-49). Therefore, it would have been obvious to combine Huang and Carter with Jamtgaard for the benefit of exporting the stored data into a document database and allowing thin clients to find an appropriate server to perform print rendering services to obtain the invention as specified in claim 1.

As per claim 2, Jamtgaard, Carter and Huang disclose the limitations of claim 1 as described above. Huang also discloses separating text data from font or glyph data (See Huang, Figure 5, Page 12, lines 24-26, and Page 13, lines 1-3). Jamtgaard, Carter and Huang are analogous art because they are from the same field of endeavor of manipulating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the separation of text and font data of Huang with the document generation method of Jamtgaard, Carter and Huang. The motivation for doing so would have been to provide an editing environment to alter the font attributes such as font type, font style, font color, font size and font effects for selected data elements (See Huang, Page 12, lines 12-15). Therefore, it would have been obvious to combine Huang with Jamtgaard, Carter and Huang for the benefit of providing an editing environment to alter font attributes of selected data elements to obtain the invention as specified in claim 2.

As per claim 3, Jamtgaard, Carter and Huang disclose the limitations of claim 1 as described above. Jamtgaard also discloses generating respective files, or cards, for the text data, graphics data, and contextual definitions (See Jamtgaard, Column 17, lines 1-5, and lines 28-36).

As per claims 5 and 8, Jamtgaard, Carter and Huang disclose the limitations of claim 1 as described above. Huang also discloses permitting a user to specify at least one property of the

first file, including a template type (See Huang, Page 12, lines 15-24, and Figure 5) before that first file is generated (See Huang, Page 12, lines 10-15). Jamtgaard, Carter and Huang are analogous art because they are from the same field of endeavor of manipulating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the specification by the user of a property of the first file, including a template type, before the file is generation of Huang with the method of Jamtgaard, Carter and Huang. The motivation for doing so would have been to provide an editing environment to alter the font attributes such as font type, font style, font color, font size and font effects for selected data elements (See Huang, Page 12, lines 12-15). Therefore, it would have been obvious to combine Huang with Jamtgaard, Carter and Huang for the benefit of providing an editing environment to alter font attributes of selected data elements to obtain the invention as specified in claims 5 and 8.

As per claim 9, Jamtgaard, Carter and Huang disclose the limitations of claim 1 as described above. Jamtgaard also discloses transmitting the data to a parser, or content cutter, to determine if the data is text data or graphics data (See Jamtgaard, Column 13, lines 24-44) and transmitting the data to a formatter, or layout processor, to determine the optimal format for the data (See Jamtgaard, Column 13, lines 27-34).

As per claim 10, Jamtgaard, Carter and Huang disclose the limitations of claim 1 as described above. Huang also discloses transmitting the data to a file manager, or transformation module, after the data is divided but before the file is generated (See Huang, Page 13, lines 4-8, lines 24-26, and Page 14, line 1). Jamtgaard, Carter and Huang are analogous art because they are from the same field of endeavor of manipulating electronic data. At the time of the invention

it would have been obvious to a person of ordinary skill in the art to include the transmitting of the data to a file manager, or transformation module, after the data is divided but before the file is generated, as disclosed by Huang, with the method of Jamtgaard, Carter and Huang. The motivation for doing so would have been to provide an editing environment to alter the attributes for selected data elements (See Huang, Page 12, lines 12-15). Therefore, it would have been obvious to combine Huang with Jamtgaard and Huang for the benefit of providing an editing environment to alter attributes of selected data elements to obtain the invention as specified in claim 10.

As per claim 11, Jamtgaard, Carter and Huang disclose the limitations of claim 1 as described above. Huang also discloses that the application program includes a word processing program (See Huang, Page 3, lines 4-7, and Page 5, lines 6-7). Jamtgaard, Carter and Huang are analogous art because they are from the same field of endeavor of manipulating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the word processing program of Huang with the method of Jamtgaard, Carter and Huang. The motivation for doing so would have been to provide a word processing view as well as a structural view of the data (See Huang, Page 3, lines 3-4). Therefore, it would have been obvious to combine Huang with Jamtgaard, Carter and Huang for the benefit of providing provide a word processing view as well as a structural view of the data to obtain the invention as specified in claim 11.

As per claim 12, Jamtgaard, Carter and Huang disclose the limitations of claim 1 as described above. Jamtgaard also discloses including a text portion in XML format, if the data received from the application program includes text data, and a graphics portion, if the data

received from the application program includes graphics data (See Jamtgaard, Column 13, lines 24-50).

As per claim 21, Jamtgaard, Carter and Huang disclose the limitations of claim 1 as described above. Jamtgaard also discloses that data is sent from the application program to a specified website location (See Jamtgaard, Column 13, lines 51-53). Carter also discloses that the data is in the form of a print stream (See Carter, Column 5, lines 66-67, and Column 6, lines 1-2). Jamtgaard, Carter and Huang are analogous art because they are from the same field of endeavor of manipulating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the data in the form of a print stream of Carter with the data of Jamtgaard. The motivation for doing so would have been to generate and transmit data in a print-ready format that is device independent (See Carter, Column 5, lines 55-65). Therefore, it would have been obvious to combine Carter with Jamtgaard, Carter and Huang for the benefit of generating and transmitting data in a print-ready format that is device independent to obtain the invention as specified in claim 21.

As per claim 22, Jamtgaard, Carter and Huang disclose the limitations of claim 21 as described above. Jamtgaard also discloses performing the dividing and generating steps by a computer program associated with a website location (See Jamtgaard, Column 13, lines 24-67).

As per claim 13, Jamtgaard, Carter and Huang disclose the limitations of claim 12 as described above. Huang also discloses including a glyph and font portion in XSL format, if the data received from the application program includes text data (See Huang, Figure 10, and Page 14, lines 11-22). Jamtgaard, Carter and Huang are analogous art because they are from the same field of endeavor of manipulating electronic data. At the time of the invention it would have

Art Unit: 2176

been obvious to a person of ordinary skill in the art to include the inclusion of glyph and font portion in XSL format of Huang with the document generation method of Jamtgaard, Carter and Huang. The motivation for doing so would have been to provide an editing environment to alter the font attributes such as font type, font style, font color, font size and font effects for selected data elements (See Huang, Page 12, lines 12-15). Therefore, it would have been obvious to combine Huang with Jamtgaard, Carter and Huang for the benefit of providing an editing environment to alter font attributes of selected data elements to obtain the invention as specified in claim 13.

As per claim 14, Jamtgaard, Carter and Huang disclose the limitations of claim 1 as described above. Jamtgaard also discloses that the file has a first file format that is different from a file format of the application program (See Jamtgaard, Claim 1).

As per claims 15-17, Jamtgaard discloses a computer system and computer readable medium including at least one server (See Jamtgaard, Figure 4, and Column 3, lines 17-18), at least one user computer coupled to the server through a network (See Jamtgaard, Column 6, lines 21-24 and Column 7, lines 1-5), where the server includes a program stored therein (See Jamtgaard, Figure 4, element 42), where the program receives data from at least one application program (See Jamtgaard, Column 8, lines 25-46, and Figure 5, element 60), where the program divides the data into text data, graphics data, and context data (See Jamtgaard, Column 13, lines 24-67, and Column 14, lines 1-3), and where the program generates cards for storing a portion of the text data, graphics data, or context data, where at least a portion of the context data is stored in XML format (See Jamtgaard, Column 13, lines 45-50). Jamtgaard does not disclose expressly generating a file for storing at least a portion of the data. Huang discloses generating a file to

store data (See Huang, Page 13, lines 21-23). Jamtgaard also does not disclose expressly registering with an operating system of a computer as a printer driver and receiving the data in the form of a print stream. Carter discloses registering a print device with a server (See Carter, Column 5, lines 43-54) and receiving data in the form of a print stream (See Carter, Column 5, lines 66-67, and Column 6, lines 1-2). Jamtgaard, Huang and Carter are analogous art because they are from the same field of endeavor of manipulating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the file of Huang with the storage of at least a portion of data of Jamtgaard. The motivation for doing so would have been to enable the export of data into a document database (See Huang, Page 13, lines 21-24). At the time of the invention it would also have been obvious to include the registering of the print driver of Carter with the method of Jamtgaard. The motivation for doing so would have been to allow thin clients to find an appropriate server to perform print rendering services (See Carter, Column 5, lines 48-49). Therefore, it would have been obvious to combine Huang and Carter with Jamtgaard for the benefit of exporting the stored data into a document database and allowing thin clients to find an appropriate server to perform print rendering services to obtain the invention as specified in claims 15-17.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jamtgaard (U.S. Patent 6,430,624 B1) in view of Huang (U.S. Provisional Application 60/179,330) and Carter (U.S. Patent 6,201,611 B1) as applied to claim 5 above, and further in view of Barile (U.S. Patent 6,560,621 B2).

As per claim 6, Jamtgaard, Carter and Huang disclose the limitations of claim 5 as described above. Jamtgaard, Carter and Huang do not disclose expressly including a location for the file. Barile discloses that a property specified is a location for the file. (See Barile, Column 5, lines 1-5). Jamtgaard, Huang, Carter and Barile are analogous art because they are from the same field of endeavor of generating and formatting electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the specific property being the location of the file, as disclosed by Barile, with the method for generating electronic documents of Jamtgaard, Carter and Huang. The motivation for doing so would have been to provide the information necessary to a print driver to allow the document to be printed. (See Barile, Column 4, lines 65-67). Therefore, it would have been obvious to combine Barile with Jamtgaard, Carter and Huang for the benefit of printing the document to obtain the invention as specified in claim 6.

12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jamtgaard (U.S. Patent 6,430,624 B1) in view of Huang (U.S. Provisional Application 60/179,330) and Carter (U.S. Patent 6,201,611 B1) as applied to claim 5 above, and further in view of DeRose (U.S. Patent 5,557,722).

As per claim 7, Jamtgaard, Carter and Huang disclose the limitations of claim 5 as described above. Jamtgaard, Carter and Huang do not disclose expressly that a property specified is security information for a file. DeRose discloses that attributes may be modified to provide security for a document. (See DeRose, Column 8, line 67, and Column 9, lines 1-9). Jamtgaard, Carter, Huang, and DeRose are analogous art because they are from the same field of

endeavor of generating and formatting electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the method of generating electronic documents of Jamtgaard, Carter and Huang with the modifiable attribute based on security considerations of DeRose. The motivation for doing so would have been to allow for user customization of the output data based on specific concerns, such as providing security for the document. (See DeRose, Column 9, lines 2-5). Therefore, it would have been obvious to combine DeRose with Jamtgaard, Carter and Huang for the benefit of providing document security to obtain the invention as specified in claim 7.

13. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jamtgaard (U.S. Patent 6,430,624 B1) in view of and Carter (U.S. Patent 6,201,611 B1), and Ballantyne (U.S. Patent 6,687,873 B1).

As per claim 19, Jamtgaard discloses a computer system including an operating system operating on at least one computer (See Jamtgaard, Column 4, lines 39-44), and an application program operating on the computer (See Jamtgaard, Column 4, lines 39-44). Jamtgaard does not disclose expressly creating a format independent document. Ballantyne discloses generating a format independent document (See Ballantyne, Column 1, lines 56-67, and Column 2, lines 1-3). Jamtgaard also does not disclose expressly an additional program for handling print requests from the application program using the operating system and manipulating at least one data stream to create a format independent document, where the at least one data stream includes a print stream, and the additional program is registered with the operating system as a print driver. Carter discloses functionality to handle print requests in the form of a print stream of data (See

Carter, Column 5, lines 66-67, and Column 6, lines 1-2). Carter also discloses registering a print device with a server (See Carter, Column 5, lines 43-54). Jamtgaard, Ballantyne and Carter are analogous art because they are from the same field of endeavor of manipulating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the functionality to handle print requests of Carter with the method of Jamtgaard. The motivation for doing so would have been to generate and transmit data in a print-ready format that is device independent (See Carter, Column 5, lines 55-65). At the time of the invention it would also have been obvious to a person of ordinary skill in the art to include the format independent document of Ballantyne with the program of Jamtgaard. The motivation for doing so would have been to make conventional legacy reports or data available in different formats (See Ballantyne, Column 1, lines 56-58). Therefore, it would have been obvious to combine Jamtgaard with Carter and Ballantyne for the benefit of generating and transmitting data in a print-ready format that is device independent, and for make conventional legacy reports or data available in different formats, to obtain the invention as specified in claim 19.

As per claim 20, Jamtgaard, Ballantyne and Carter disclose the limitations of claim 19 as described above. Jamtgaard also discloses a parser, or content cutter, component for separating text data from graphics data (See Jamtgaard, Column 13, lines 24-67, and Column 14, lines 1-3), a formatter component for formatting the text data or graphics data (See Jamtgaard, Column 13, lines 19-22, and Figure 10, element 62), and a file manager component for ensuring that the format independent document is created in a specified location (See Jamtgaard, Column 10, lines 48-56).

Response to Arguments

14. Applicant's arguments with respect to claims 1-3, 5-17, and 19-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Niehoff discloses a retro/prospective on APL Graphpak.
- Alam (U.S. Patent 6,336,124 B1) discloses conversion data representing a document to other formats for manipulation and display.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2176

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
7/19/2005